

REMARKS

Claims 16 and 21 - 31 are pending.

Claim Rejections Under 35 U.S.C §103

Claims 16, 21, 23, 24, and 28 - 31 stand rejected as allegedly being unpatentable over JP 46-026406 (JP) in view of U.S. Patent No. 5,575,957 (Okuda). Applicants respectfully traverse these rejections.

The Office has failed to establish the requisite motivation to combine these references. JP discloses a filler of a titanium oxide material. See, e.g., the second full paragraph at page 3 of the English translation. Furthermore, JP discloses that an organic titanium compound or a titanium halide compound may be used alone or made into a composition containing other processing agents. See, e.g., first full paragraph at page 5 of the English translation. JP fails to teach or suggest inclusion of an electrically conductive pigment, much less tin oxide particles as disclosed by Okuda. See, e.g., column 2, lines 35 - 48. Consequently, Applicants respectfully submit that the Office has failed to establish a *prima facie* case of obviousness because the Action fails to establish the requisite motivation to combine these references. Therefore, Applicants respectfully submit that these rejections should be withdrawn.

Claims 16, 21, 23, 24 and 26 - 31 stand rejected as allegedly being unpatentable over JP in view of Okuda and further in view of U.S. Patent No. 4,740,269 (Berger). Because the Action has failed to establish the requisite motivation to combine JP with Okuda, Applicants respectfully submit that the addition of Berger fails to cure this deficiency. Consequently, the Office has failed to establish the requisite motivation to combine these references, and Applicants respectfully submit that these rejections should be withdrawn.

Claim 25 stands rejected as allegedly unpatentable over U.S. Patent No. 5,897,938 (Shinmoto) in view of U.S. Patent No. 6,019,831 (Schmidt). The Action at page 8 asserts that the applied art meets the feature of "absorber material having a pale intrinsic color" because the applied art comprises a paper containing the same materials as Applicants' claimed absorber material. However, as discussed in Applicants' Reply filed 9 August 2004, Schmidt discloses pigments having a high color intensity and high hiding power. See, e.g., column 4, lines 20 - 29. This teaching clearly indicates that Schmidt does not teach or suggest an absorber material having a pale intrinsic color. The citation of Shinmoto fails to cure this deficiency. Consequently, Schmidt's disclosure clearly indicates that the combination of these references, as alleged, would not provide an absorber material having a pale intrinsic color. Thus, these pigments would be inappropriate for marking paper because in such an application the absorber should have a very pale, neutral intrinsic color. Consequently, the alleged combination fails to teach or suggest the present invention.

Claim 22

In the Office Action summary, claims 16 and 21 - 31 are indicated as rejected. However, claim 22 is not subject to a particular ground of rejection at pages 3 - 8 in the detailed discussion of the Office Action. Consequently, absent providing a specific ground of rejection, Applicants respectfully submit that claim 22 should be indicated as allowed in the next paper from the Office. However, if the Examiner does assert a specific rejection ground in the next paper from the Office, Applicants respectfully submit that such a rejection should not be made final because Applicants have not been able to address the patentable features of claim 22 in view of the prior art.

In view of the above, applicants respectfully request favorable reconsideration. If there are any remaining issues which can be expedited by a telephone conference, the Examiner is courteously invited to telephone counsel at the number indicated below.

22 March 2005

Reply to 9/22/04 Office Action

Page 4

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

MILLEN, WHITE, ZELANO &
BRANIGAN, P.C.
Arlington Courthouse Plaza 1, Suite 1400
2200 Clarendon Boulevard
Arlington, Virginia 22201
Telephone: (703) 243-6333
Facsimile: (703) 243-6410

James E. Roland, Reg. No. 37,432
Attorney/Agent for Applicants

Attorney Docket No.: MERCK-2009

Date: 22 March 2005

JER/jqs

K:\Merck\2009\Reply 3-21-05.doc

MERCK-2009